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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,180	04/24/2001	Hiroyuki Miyake	206347US3	2638

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EXAMINER

ENG, GEORGE

ART UNIT PAPER NUMBER

2643

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/840,180		MIYAKE, HIROYUKI	
	<b>Examiner</b>		<b>Art Unit</b>	
	George Eng		2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/12/04, 2/3/05</u>  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is in response to the amendment filed 12/20/2004.

### ***Information Disclosure Statement***

2. The information disclosure statements filed 10/12/2004 and 2/3/2005 have been considered.

### ***Claim Rejections - 35 USC § 112***

3. Claims 1 and 5-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the amended language further defines a connecting member disposed between and fused to the first and second component holding units, which was not disclosed in the specification. Accordingly, the specification merely define holding portions are connected with each other to form the single-piece holder (page 5 lines 16-17), but fails to define a connecting member disposed between and fused to the first and second component holding units as shown in the amended claim. Thus, the amended claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 5-8 are also rejected because of depending on claim 1 containing the same deficiency.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Sekikawa et al (JP 10042383A hereinafter Sekikawa).

Regarding claim 1, Applicant's admitted prior art figure 12 discloses a holder comprising a first component holding unit (20) configured to hold an image pickup device on a main surface of a board (4) and a second component holding unit (20) configured to hold another component on the main surface at a location different from a location of the first component holding unit. Applicant's admitted prior art differs from the claimed invention in not specifically teaching a connecting member disposed between and fused to the first and second component holding units. However, Sekikawa teaches a holder member (5, figure 3) having a first holder part (6, figure 3) for holding a first component (3, figure 3) and a second holder part (7, figure 3) for holding a second component (4, figure 3), wherein the first holder part and the second holder part are

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integrally molded (abstract and detailed description) so that one skill in the art would recognize the holding member having a connecting member disposed between and fused into the first holder part and the second holder part in order to reduce components mark and makes easy to position and assembly of each part material. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Applicant's admitted prior art in having connecting member disposed between and fused to the first and second component holding units, as per teaching of Sekikawa, because it reduce components mark and makes easy to position and assembly of each part material. Furthermore, it is old and notoriously well known in the art of no invention to cast in one piece an article, which has formerly been cast in two pieces and put together, because it is merely a modification of the technique or knowledge know before the filing of the present application. In re Larson, 144 USPQ 347 (CCPA 1965), In re Lockhart, 90 USPQ 214 (CCPA 1951) and Howard v. Detroit Strove Works, 150 U.S. 164 (1893).

Regarding claim 5, Applicant's admitted prior art discloses the second component holding unit configured to hold a receiver (3, figure 11).

Regarding claim 6, Sekikawa discloses the second component holding unit configured to hold a display device (4, figure 3 and abstract).

Regarding claim 7, Applicant's admitted prior art discloses the holder formed with resin by integral molding (figures 11-12), as well as Sekikawa (abstract).

Regarding claim 8, Applicant's admitted prior art discloses the holder for holding a variety of devices on a board within a portable telephone (page 1 lines 6-8), as well as Sekikawa (abstract and detailed description).

6. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Sekikawa et al (JP 10042383A hereinafter Sekikawa) and Suzuki et al. (JP 11191865A).

Regarding claim 2, Applicant's admitted prior art figure 12 discloses a holder comprising a first component holding unit (20) configured to hold an image pickup device on a main surface of a board (4) and a second component holding unit (20) configured to hold another component on the main surface at a location different from a location of the first component holding unit. Applicant's admitted prior art differs from the claimed invention in not specifically teaching the first and second component units being formed as a single piece. However, Sekikawa teaches a holder member (5, figure 3) having a first holder part (6, figure 3) for holding a first component (3, figure 3) and a second holder part (7, figure 3) for holding a second component (4, figure 3), wherein the first holder part and the second holder part are integrally molded (abstract and detailed description) so that one skill in the art would recognize the first and second component units being formed as a single piece in order to reduce components mark and makes easy to position and assembly of each part material. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Applicant's admitted prior art in having the first and second component units being formed as a single piece, as per teaching of Sekikawa, because it reduce components mark and makes easy to position and assembly of each part material. In addition, it is old and notoriously well known in the art of no invention to cast in one piece an article, which has formerly been cast in two pieces and put together, because it is merely a modification of the technique or knowledge know before the

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filing of the present application. In re Larson, 144 USPQ 347 (CCPA 1965), In re Lockhart, 90 USPQ 214 (CCPA 1951) and Howard v. Detroit Strove Works, 150 U.S. 164 (1893). Furthermore, neither Applicant's admitted prior art nor Sekikawa specifically teaches the first component holding unit being configured to hold a substantial portion of a surface of the image pickup device in directed contact to said main surface. However, Suzuki teaches to attain a remarkably thin profile in a way that a height of a solid-state image pickup element is substantially equal to a maximum thickness of a mounted printed circuit board by providing a holding unit to hold a substantial portion of a surface of the solid-state image pickup element in direct contact to a main surface of a substrate (abstract and figure 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Applicant's admitted prior art and Sekikawa in having the first component holding unit being configured to hold a substantial portion of a surface of the image pickup device in directed contact to said main surface, as per teaching of Suzuki, because the thickness of the substrate, which mounts solid-state image pick-up element, is reduced.

Regarding claims 3-4, Suzuki discloses the first component holding unit being in a frame shape configured to surround and hold a periphery of the solid-state image pick-up element with upper and bottom surfaces opened (figure 1).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tue-Fri 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "George Eng". The signature is fluid and cursive, with the first name "George" written in a larger, more prominent script than the last name "Eng".

George Eng  
Primary Examiner  
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